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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/031,698

01/23/2002

Tatsuki Shiota

Q68142

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EXAMINER

WANG, SHENGJUN

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

04/16/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/031,698	<b>Applicant(s)</b> SHIOTA ET AL.	
	<b>Examiner</b> Shengjun Wang	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7 and 12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 26, 2008 has been entered.

### *Claim Rejections 35 U.S.C. 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers et al. (WO 0031032, IDS 02/23/2005).

Rogers teaches pyrrolidine derivatives-CCR-3 receptor antagonist with a general formula I, wherein Z may be N, A may be -NCO-, B is alkylene with 1-4 carbon inclusive wherein one of the carbon atom may optionally be replaced by -N(R<sub>4</sub>)-, -NR<sub>2</sub>C(O)NR<sub>3</sub>-, etc. (*see page 4, lines 13-17*), Ar<sub>1</sub> and Ar<sub>2</sub> may be aromatic or heteroaromatic rings, wherein the heteroaryl means monovalent monocyclic or bicyclic aromatic radical of 5 to 10 ring atoms including pyridyl, pyrrolyl, pyrimidinyl etc. , which are meet the all the limitation herein defined except that n, as herein defined is 1, and the claimed compounds require n is 0. See pages 3-7. Those compounds are disclosed as useful pharmaceutical agent for treating CCR-3 receptor associated disorders,

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particularly, those eosinophil-mediated inflammatory diseases. See, the abstract, and pages 1-2, and the claims.

Rogers does not teach expressly the employment of the particular compound herein treating the eosinophilic disorders herein.

However, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to use the compounds herein as CCR-3 receptor antagonist for treating the eosinophilic disorders herein.

A person of ordinary skill in the art would have been motivated to use the compounds herein as CCR-3 receptor antagonist for treating the eosinophilic disorders herein. Because the instant compounds are structural homologs of the reference compounds, or structurally similar to the prior art compounds. One having ordinary skill in the art would have been motivated to prepare the instantly claimed compound because such structurally homologous compounds are expected to possess similar properties. It has been held that compounds that are structurally homologous to prior art compounds are prima facie obvious, absent a showing of unexpected results. In re Hass, 60 USPQ 544 (CCPA 1944); In re Henze, 85 USPQ 261 (CCPA 1950). Further, Prior art structures do not have to be true homologs or isomers to render structurally similar compounds prima facie obvious. In re Payne, 606 F.2d 303, 203 USPQ 245 (CCPA 1979).

### ***Response to the Arguments***

Applicants' remarks submitted January 28, 2008 and the declaration under 37 C.F.R. 1.132 have been fully considered, but are not persuasive.

2. The declaration under 37 CFR 1.132 filed January 28, 2008 is insufficient to overcome the rejection of claims 7 and 12 based upon Roger et al. as set forth in the last Office action because: The declaration assert CH<sub>2</sub> and a bond are not are not bioisosters and removal of a CH<sub>2</sub> unit from a molecule would change the shape of the molecule. The declaration are not persuasive to the rejections on the record as the rejection are based on the arguments that the compounds herein claimed are homologues of the prior art compounds. Particularly, considering the size of compounds herein, and the fact that the amide group linked to a methine (CH) group, the similarity between the chemical structures and properties is sufficiently close that one of ordinary skill in the art would have been motivated to make the claimed compounds by removing the methylene unit (CH<sub>2</sub>) in searching for new CCR3 antagonist.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang whose telephone number is (571) 272-0632. The examiner can normally be reached on Monday to Friday from 7:00 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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/Shengjun Wang/  
Primary Examiner, Art Unit 1617